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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/061,458	02/01/2002	Linh A. Dinh	S63.2-10389-US01	9614
499 7590 07/21/2011 VIDAS, ARRETT & STEINKRAUS, P.A. SUITE 400, 6640 SHADY OAK ROAD EDEN PRAIRIE, MN 55344				
EXAMINER				
STEWART, ALVIN J				
ART UNIT		PAPER NUMBER		
3774				
MAIL DATE		DELIVERY MODE		
07/21/2011		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/061,458

## Applicant(s)

DINH ET AL.

## Examiner

ALVIN STEWART

## Art Unit

3774

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2010 and 06 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Reissue Applications***

Claims 1-33 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Below is the Examiner's argument with respect to the improper recapture.

In order to apply the recapture rule, a three-step process is required:

- 1) first, determine whether, the reissue claims are broader in scope than the original patent claims;
- 2) next, determine whether the broader aspects of the reissue claims relate to subject matter surrendered in the original prosecution; and
- 3) finally, we determine whether the reissue claims were materially narrowed in other respects, so that the claims may not have been enlarged and hence avoid the recapture rule.

First step – Was There broadening?

Yes, the Examiner believes that there is broadening of the claims. For example, the Applicant's representative deleted the phrase: "extremity which moves axially inwardly, with respect to the associated connecting bar end," "radial", and "axial inward distance traveled by" in independent claims 1 and 5.

Regarding the rest of the independent claims, the Examiner believes that the new independent claims does not show the structure limitations claimed in the patent case.

For the above reasons, the claims are all broader than before.

Second Step – Does Any Broadening Aspect of the Reissued Claim Relate to Surrendered Subject Matter?

In order to say yes to step two, two sub-steps must be follow:

A) One must determine whether applicant surrendered any subject matter in the prosecution of the original application (now the patent to be reissued).

An original patent claim limitation now being omitted or broadened in the present reissue application was originally relied upon by applicant in the original application to make the claims allowable over the art, the omitted limitation relates to subject matter previously surrendered by applicant. The reliance by applicant to define the original patent claims over the art can be by presentation of new/amended claims to define over the art, or an argument/statement by applicant that a limitation of the claim(s) defines over the art.

In the Applicant's representative arguments filed on 06/01/99, especially pages 5-6, clearly disclose all the phrases that the Applicant's representative mentions that the prior art do

not have. For example, page 5 discloses that the prior art does not show: “a central connecting beam (connecting bar) with a pair of arms on either end, the arms joined by a looped member”; “connecting bar having a pair of arms at each end”; “arms pivoting outwardly from the connecting bar”; “arms and expandable looped members are constructed and dimensioned so that the radial outward distance traveled by arms outer ends.... is approximately equal to the axial inward distance traveled by the ...looped member extremity, as the stent is expanded.”; and “an expandable looped member which joins arm pairs at each end of a connecting bar”. In order to avoid recapture rule, the Applicant’s representative must keep each an every word that was argued in the Applicant’s remarks.

The Examiner believes that those arguments make the case allowable, therefore, that language must stay in the claims in order to avoid recapture.

NOTE: the Examiner wants to point out that all the independent claims are broader than the original claims, therefore, they are all improperly recaptured.

B) There is no surrender of the claims.

Third Step – Were the reissued claims materially narrowed in other respects, so that the claims may not have been enlarged and hence avoid the recapture rule?

There are two different types of analysis that must be performed. If the reissue claim “fails” either analysis, recapture exists.

First, the reissue claim must be compared to any claims canceled or amended during the prosecution of the original application. The first analysis does not fail because there was never a canceled claim or an amended claim.

Second, point two “fails” because as shown above, the omitted limitations presented by this reissue were part of the arguments presented in the original application (now the patent to be reissued) to overcome the prior art. For the above reasons, the Examiner believes that the above rejection is proper.

For the above reasons the Examiner believes that independent claims 1 and 5 have broaden subject matter previously surrendered and that independent claims 16, 21, 23, 25 and 28 contain little, if any, of the surrendered subject matter. Finally, the dependent claims do not cure this defect.

**The Examiner wants to remind the Applicant's representative that any substantive amendment made to avoid the recapture rejection will require a catch-up declaration stating no deceptive intent.**

#### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALVIN STEWART whose telephone number is (571)272-4760. The examiner can normally be reached on Monday-Friday 7:00AM-5:30PM(1 Friday B-week off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Isabella can be reached on 571-272-4749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alvin J Stewart/  
Primary Examiner, Art Unit 3774

July 06, 2011.